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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,970	03/08/2004	Michael Conte	4171/8/1	8633

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MCCARTER & ENGLISH, LLP
FOUR GATEWAY CENTER
100 MULBERRY STREET
NEWARK, NJ 07102

EXAMINER

PRASAD, SONAL

ART UNIT PAPER NUMBER

3767

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/795,970	Applicant(s) CONTE, MICHAEL	
	Examiner Sonal Prasad	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-11, 13-17 is/are rejected.
- 7) ☒ Claim(s) 7, 8 and 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/21/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Hajishoreh (US 5,451,214). Hajishoreh discloses a safety syringe and cap holding device comprising (claim 4, lines 1-6): a syringe having a body portion and a needle assembly interconnected with the body portion (claim 4, lines 15-18) the needle assembly including a needle and a hub (claim 4, lines 10-14); a cover removably attached to the hub and covering the needle; a housing having a receptacle for receiving the cover (Fig. 6); and means in the housing for disengaging the cover from the hub to allow the syringe and needle assembly to be withdrawn from the housing for use while the cover remains in the housing. (Fig. 6)

Regarding claim 2, Hajishoreh discloses the hub comprising at least one recess-disposed annularly about the hub. (Fig. 6 & 7)

Regarding claim 3, Hajishoreh discloses the cover comprising at least one protrusion for engagement with the at least one recess of the hub. (Fig. 7)

Regarding claim 4, Hajishoreh discloses wherein the means for disengaging the cover comprises a linkage system in the housing for moving the at least one protrusion out of engagement with the at least one recess for disengaging the cover from the hub. (Fig. 6 & 7)

Regarding claim 5, Hajishoreh discloses the linkage system comprises one or more hooks for the at least one recess to disengage the cover from the hub. (Fig. 4, #156)

Regarding claim 6, Hajishoreh discloses the linkage system is actuated remotely from the housing. (Fig. 2 & 7).

Regarding claim 9, Hajishoreh discloses further comprising means in the housing for selectively retaining or releasing the cover from engagement within the housing. (Fig. 8)

Regarding claim 10, Hajishoreh discloses the means for selectively retaining or releasing the cover comprises a linkage system in the housing for engaging and disengaging a tip of the cap. (Fig. 8 & 11)

Regarding claim 11, Hajishoreh discloses the means for selectively retaining or releasing the cover comprises one or more solenoids having one or more hooks for engaging and disengaging the cap in the holder. (Fig. 10)

Regarding claim 13, Hajishoreh discloses a method of using a syringe comprising: providing a needle assembly including a hub, a needle, and a cover interconnected with the hub and covering the needle; engaging the needle assembly with a syringe body; inserting the needle assembly into a housing', activating a device within the housing to permit the needle to be withdrawn from the cover; and using the syringe. (claim 10)

Art Unit: 3767

Regarding claim 14, Hajishoreh discloses the method further comprising reinserting the syringe body and needle into the cover in the housing and actuating the device to remove the syringe body, needle assembly, and cover from the holder. (claim 10 & 11)

Regarding claim 15, Hajishoreh discloses the method wherein the step of activating the device comprises actuating a switch remote from the needle. (claim 10 & 11)

Regarding claim 17, Hajishoreh discloses the method further comprising retaining the cover to remain in the housing when the syringe is being used. (claim 8)

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claim 12 is rejected under 35 U.S.C 103(a) as being unpatentable over Hajishoreh in view of Mercado et al. (US 5,540,665). The claim differs from Hajishoreh in disclosing a weighted base. Mercado discloses a housing comprising a weighted

Art Unit: 3767

base. (Detailed description 33). It would have been obvious at the time of invention to one of ordinary skill in the art to include a weighted base to stabilize and anchor the device.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hajishoreh in view of Kanda et al (US 6,780,188 B2). The claim differs from Hajishoreh in disclosing the foot switch used for activating the device. Kanda et al discloses the method of activating the device depressing a foot switch. (Fig. 1, #14, detailed description 6). It would have been obvious at the time of invention to one of ordinary skill in the art to include a foot switch for activation to improve the efficiency of the device.

Allowable Subject Matter

7. Claims 7 & 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not disclose or render obvious at the time the invention was made the combination as claimed specifically including solenoids as shown in claim 7.

Conclusion

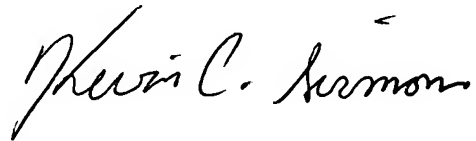
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonal Prasad whose telephone number is 571-272-3383. The examiner can normally be reached on M-F.

Art Unit: 3767

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sonal Prasad
Examiner
Art Unit 3767

A handwritten signature in black ink, reading "Kevin C. Sirmons". The signature is written in a cursive, flowing style with a long horizontal stroke at the end.